

REMARKS

Applicants have cancelled claims 114, 117, and 118; and amended claims 61-64, 66-68, 70-74, 76-80, 84, 85, 87-91, 93, 94, 98, 99, 101-103, 105-108, 115, 116, 121, 122, 124-128, 131, 132, 136, 137, 139-141, and 143-146. Claims 61-113, 115, 116, and 119-146 are pending in the above-captioned patent application, of which claims 61, 101-108, 115, and 139-146 are presented for examination, and claims 62-100, 109-113, 116, 118, and 120-138 have been withdrawn from consideration.

§112, Second Paragraph, Rejection of Claim 117

Applicants respectfully note that the Examiner's rejection of claim 117 under 35 U.S.C. § 112, second paragraph, is moot in light of the cancellation of this claim.

§102(b) Rejection of Claims 61, 101, 102, 105, 108, 115, 139, 140, 143, and 146

The Examiner rejected claims 61, 101, 102, 105, 108, 115, 139, 140, 143, and 146 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,774,452 to Wolosewicz ("*Wolosewicz*"). Applicants respectfully traverse this rejection because *Wolosewicz* fails to anticipate these claims. To properly anticipate Applicants' claims under 35 U.S.C. § 102(e), each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. § 2131. *Wolosewicz* fails to anticipate these claims because *Wolosewicz* does not teach each and every element recited in amended independent claim 61, from which claims 101-108 depend, or amended independent claim 115, from which claims 139-146 depend.

Claim 61

Claim 61 is not anticipated by *Wolosewicz* at least because *Wolosewicz* fails to teach a **toy system** comprising, inter alia, a **toy** that comprises, inter alia, **“an acousto-electric transducer operable to receive and convert the acoustic signal into a corresponding electrical signal”** and **“a decoder operable to de-spread the electrical signal obtained from said acousto-electric transducer, in order to regenerate the data signal”** (emphasis added), as recited in independent claim 61 as amended.

Wolosewicz discloses encoding and decoding machine readable signals in audio signals for producing humanly perceived audio signals (Abstract). “[D]igital information is encoded into a spread-spectrum signal by conversion into a pseudorandom noise (PN) sequence” (Col. 18, lines 50-53). “[A]udio signals” can be recorded “on any medium capable of recording such signals, include [sic] RAM, ROM, CD ROM ...” (Col. 20, lines 54-56). A “decoding device 170 ... includes an audio plug 172 which is designed to fit into a standard audio-out jack of the type commonly found on tape players, receivers, televisions and the like” (Col. 12, lines 51-56). “The decoder includes three audio jacks, 174, 176 and 178” (Col. 12, lines 56-57). “The jack 178 is an audio-out jack, from which brief recorded segments of musical selections whose labels are currently stored in the decoder can be heard” (Col. 13, lines 1-4). A “D/A converter 262” produces successive analog voltages that “are passed through a filter 264 which smooths out the steplike changes in voltage produced at the output of the D/A converter 262. The output of this filter is passed through an operational amplifier

266 to the audio out jack 178. From there the user can listen to it over a pair of earphones or plug it into a larger amplifier in order to listen to it over speakers.” (Col. 16, line 65 - col. 17, line 5).

The Examiner apparently contends that the “speakers” of *Wolosewicz* constitute the “acousto-electric transducer” recited in claim 61 (Office Action, page 4, paragraph 4). However, the “speakers” of *Wolosewicz* do not constitute the “acousto-electric transducer” because the “speakers” do not receive and convert an “acoustic signal into a corresponding electrical signal,” as required by claim 61 (Emphasis added).

Furthermore, *Wolosewicz* fails to teach “a decoder operable to de-spread the electrical signal obtained from said acousto-electric transducer, in order to regenerate the data signal” (emphasis added), as recited in claim 61. As explained above, the Examiner apparently relies on the “speakers” of *Wolosewicz* for teaching of the claimed “acousto-electric transducer” of claim 61. However, the “speakers” of *Wolosewicz* do not output an electrical signal to the “decoding device 170” of *Wolosewicz*. Thus, *Wolosewicz* does not teach “a decoder operable to de-spread the electrical signal obtained from said acousto-electric transducer” (emphasis added), as required by claim 61.

Thus, since *Wolosewicz* fails to teach each and every element of independent claim 61, claim 61 and claims 101, 102, 105, and 108 dependent therefrom are allowable over *Wolosewicz* under 35 U.S.C. § 102(b).

Claim 115

Claim 115 is not anticipated by *Wolosewicz* because *Wolosewicz* fails to teach a **toy** comprising, inter alia, **“an acousto-electric transducer operable to receive and to convert an acoustic signal into an electrical signal”** and **“a decoder operable to decode a data signal conveyed by the acoustic signal”** (emphasis added), as recited in independent claim 115 as amended.

For example, *Wolosewicz* fails to teach the “acousto-electric transducer” recited in claim 115 for the reasons discussed above in regard to the “acousto-electric transducer” of claim 61. *Wolosewicz* also fails to teach the “decoder” recited in claim 115 for the reasons discussed above in the regard to the “decoder” of claim 61.

Thus, since *Wolosewicz* does not teach each and every element of independent claim 115, claim 115 and claims 139, 140, 143, and 146 depend therefrom are allowable over *Wolosewicz* under 35 U.S.C. § 102(b).

Claims 102 and 140

Furthermore, amended claims 102 and 140 are not anticipated by *Wolosewicz* because *Wolosewicz* also fails to teach each and every element of claim 102 or claim 140. In particular, *Wolosewicz* at least fails to teach that “the responder is operable to cause the toy to output an acoustic signal determined using the data signal,” as recited in claims 102 and 140.

The Examiner relies on the “decoding device 170” of *Wolosewicz* as allegedly constituting the “toy” recited in claim 102 and the “toy” recited in claim 140 (Office Action, page 4). However, the “decoding device 170” of *Wolosewicz* does not constitute the “toy” of claim 102 or claim 140 for at least the reason that the “decoding device 170” does not “output an acoustic signal determined using the data signal” (emphasis added), as required by amended claims 102 and 140.

Thus, claims 102 and 140 are also allowable over *Wolosewicz* for this additional reason.

Claim 108 and 146

Furthermore, amended claims 108 and 146 are not anticipated by *Wolosewicz* because *Wolosewicz* fails to teach each and every element of claim 108 or claim 146. For example, *Wolosewicz* fails to teach a “toy” comprising “a generator operable to generate a data signal” or “a spreader operable to spread the generated data signal to form a spread signal,” as recited in claims 108 and 146.

The Examiner relies on the “decoding device 170” of *Wolosewicz* as allegedly constituting the “toy” recited in claim 108 and the “toy” recited in claim 146 (Office Action, page 4). However, *Wolosewicz* does not disclose that the “decoding device 170” comprises “a generator operable to generate a data signal” or “a spreader

operable to spread the generated data signal to form a spread signal,” as required by claims 108 and 146.

Thus, claims 108 and 146 are also allowable over *Wolosewicz* for this additional reason.

§102(b) Rejection of Claim 117

The Examiner also rejected claim 117 under 35 U.S.C. § 102(b) as being anticipated by PCT Patent Publication No. WO 97/33391 to Neubauer et al. (“*Neubauer et al.*”), of which U.S. Patent No. 6,584,138 to Neubauer et al. is referenced as a translation. As explained above, claim 117 has been canceled without prejudice or disclaimer. Thus, this rejection of claim 117 is obviated.

§103(a) Rejection of Claims 103, 104, 141, and 142

The Examiner rejected claims 103, 104, 141, and 142 under 35 U.S.C. 103(a) as being unpatentable over *Wolosewicz*. Applicants respectfully traverse this rejection because a *prima facie* case of obviousness has not been established.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In*

re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

In particular, as noted above, *Wolosewicz* fails to teach the claimed “acousto-electric transducer” and “decoder” as recited in claims 61 and 115. Claims 103, 104, 141, and 142 are thus allowable at least due to the corresponding dependence from claims 61 and 115.

Moreover, *Wolosewicz* does not teach a “responder [that] comprises a processor operable to select one of a plurality of sound files stored in a memory in dependence upon the content of the data signal, and to output the selected sound file via an electro-acoustic transducer” (emphasis added) as recited in claims 103 and 141.

Claims 104 and 142 are allowable over *Wolosewicz* for at least the reason that the Examiner relies on the “CD ROM” of *Wolosewicz* for a disclosure that the “memory” recited in claims 103 and 141 is “detachable,” as required by claims 104 and 142. However, this “CD ROM” does not store “a plurality of sound files,” from which one is selected by a “processor” of a “responder,” as recited in claim 103 or claim 141, from which claims 104 and 142, respectively, depend.

Thus, claims 103, 104, 141, and 142 are allowable over *Wolosewicz*.

§103(a) Rejection of Claims 106, 107, 144, and 145

Applicants respectfully traverse the rejection of claims 106, 107, 144, and 145 under 35 U.S.C. 103(a) as being unpatentable over *Wolosewicz* in view of U.S. Patent No. 5,090,936 to Satoh et al. ("*Satoh et al.*"). *Wolosewicz* does not teach or suggest each and every element of independent claim 61, from which claims 106 and 107 depend, or independent claim 115, from which claims 144 and 145 depend.

Claims 106 and 107

The shortcomings of *Wolosewicz* have been discussed above. *Satoh et al.* does not make up for the deficiencies of *Wolosewicz* because *Satoh et al.* also fails to teach or suggest, for example, "a decoder operable to de-spread the electrical signal obtained from said acousto-electric transducer, in order to regenerate the data signal" (emphasis added), as recited in claim 61.

Instead, *Satoh et al.* teaches a "movable decoration [that] includes a power supply, to which a sensor is connected. The sensor may be constructed so as to detect sound of a predetermined level or more. ... The movable decoration also includes a motor connected through the sensor to the power supply, a drive mechanism connected to the motor so as to be actuated thereby, and a driven element operatively connected to the drive mechanism." (Col. 1, lines 35-47)

However, the "movable decoration" of *Satoh et al.* does not comprise, for example, "a decoder operable to de-spread the electrical signal obtained from said

acousto-electric transducer, in order to regenerate the data signal" (emphasis added), as recited in claim 61. "Detecting sound of a predetermined level" does not constitute de-spreading the electrical signal to regenerate the data signal, as required by claim 61.

Moreover, there would not have been motivation for one of ordinary skill to combine the teachings of *Wolosewicz* with the teachings of *Satoh et al.* to derive the toy system recited in claim 61, for at least the reason that *Satoh et al.* is non-analogous art.

Thus, since *Wolosewicz* and *Satoh et al.* fail to teach or suggest each and every element of independent claim 61, or to provide motivation for one of ordinary skill to combine these references to derive the toy system recited in claim 61, claims 106 and 107 are allowable over *Wolosewicz* and *Satoh et al.* at least due to their dependence from claim 61.

Claim 144 and 145

The shortcomings of *Wolosewicz* have been discussed above. *Satoh et al.* does not make up for the deficiencies of *Wolosewicz* because *Satoh et al.* also fails to teach or suggest, for example, "a de-spreader operable to de-spread the electrical signal obtained from the acousto-electric transducer" (emphasis added), as recited in claim 115.

Satoh et al. teaches a "movable decoration," but the "movable decoration" does not comprise, for example, "a de-spreader operable to de-spread the electrical signal

obtained from the acousto-electric transducer” (emphasis added), as recited in claim 115. “Detecting sound of a predetermined level” does not constitute de-spreading the electrical signal obtained from the acousto-electric transducer, as required by claim 115.

Moreover, there would not have been motivation for one of ordinary skill to combine the teachings of *Wolosewicz* with the teachings of *Satoh et al.* to derive the toy recited in claim 115, for at least the reason that *Satoh et al.* is non-analogous art.

Thus, since *Wolosewicz* and *Satoh et al.* fail to teach or suggest each and every element of independent claim 115, or to provide motivation for one of ordinary skill to combine these references to derive the toy recited in claim 115, claims 144 and 145 are allowable over *Wolosewicz* and *Satoh et al.* at least due to their dependence from claim 115.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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